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EXAMINER

LIN, SHEW FEN

ART UNIT

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2166

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/624,733

Applicant(s)

KOBASHIKAWA ET AL.

Examiner

Shew-Fen Lin

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1. ☐ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

- a. This action is taken to response to amendments and remarks filed on 5/7/2007.
- b. Claims 1-29 are pending. Claims 1, 9, 16, 18, 21, and 28 are independent claims.

Claim Objections

Claim 2 recites the limitation, "...includes *an organization*; organizing the electronic address book according to *an organization* of at least a portion of the at least one archive...". It is not clear if it is a new instance of "organization" or a reference to the original organization thus lacks antecedent basis (should be preceded with "said" or "the").

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6 and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Que ("Special Edition Using Microsoft Outlook 2002", Publisher Que, May 17, 2001).

As to claims 1, 16, and 18, Que discloses a method/system/apparatus for use in populating an electronic address book (contact list reads on address book, page 7.4), comprising:

Searching, over a network, through at least one archive of e-mails for an e-mail address (search message containing word, Fig. 17.10, page 17.19, Outlook items can be in the folders within your Exchange store, i.e. remote and over the network. Click Browse to open the Select Folders dialog box. In this dialog box, expand the appropriate top-level folder if necessary, deselect any folders you don't want to search, select the folder or folders in which you want Outlook to search, and then click OK. The names of the folders you select appear in the in text box, page 7.10-7.12) based on a different application associated with each of the at least one archive (different email account with different servers/protocol, page 22.3);

evaluating the e-mail address based on a first defined criterion (evaluate based on words and phrases in any type of item, for example, search word "outlook" in the company field, page 17.14, in the same token, search can be performed for words in a message, names of message senders, etc, page 17.18-17.19, the items that match with search criteria are displayed in a table, page 17.21, also see Fig. 17.6 as an example), ; and

adding the e-mail address to the electronic address book if the first defined criterion is satisfied (view search result, select email, page 17.22, and add e-mail address to contact, page 7.45).

As to claims 2 and 17, Que discloses the elements of claim 1 as noted above and further discloses wherein the searching includes searching an "From" field, a "to" field and a "cc" field (Address fields including From, To, Cc, Bcc, page 17.30-31).

As to claim 3, Que discloses the elements of claim 1 as noted above and further discloses wherein the evaluating includes determining if the e-mail address already exists in the electronic address book, and not adding the e-mail address in the electronic address book if it already exists in the electronic address book (detect duplicate contact, choose cancel, page 7.34).

As to claims 4 and 19 Que discloses the elements of claims 3 and 18 as noted above and further discloses wherein the evaluating includes evaluating the e-mail address based on a second defined criterion (refining search with multiple criteria, pages 17.23-17.29); and the adding includes adding the e-mail address to the electronic address book if both the first and the second defined criterion are satisfied and not adding the e-mail address to the electronic address book unless both the first and second criteria are satisfied (both search criteria in the find items that match the criteria box must be satisfied to find an item, page 17.29).

As to claim 5, Que discloses the elements of claim 1 as noted above and further discloses determining if the at least one archive from which the e-mail address was retrieved includes an organization (category for a project, page 20.1); organizing the electronic address book according to an organization of at least a portion of the at least one archive from which the e-mail address was retrieved (assign category to all contacts associated with the project, page 20.1); and the adding includes adding the e-mail such that the e-mail address is added according to the organized address book (add the e-mail to that category, page 20.1).

As to claim 6, Que discloses the elements of claim 1 as noted above and further discloses generating a retrieved list of e-mail addresses retrieved during the searching that satisfy the first defined criterion (list of search result, page 17.14); and the adding includes adding the e-mail addresses if the e-mail address is confirmed to be added (page 7.45).

As to claim 20, Que discloses the elements of claim 19 as noted above and further discloses a code segment for supplying a plurality of criteria options (define more criteria, Fig. 17.14); and a code segment for receiving a selection of criteria including the first and second criteria (find items that match these criteria, Fig. 17.18).

Claims 21-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Tafoya et al. (US Patent 6,952,805, hereinafter "Tafoya").

As to claim 21, Tafoya discloses an apparatus for use in populating an electronic address book over a network (populating a resolution list over the network, resolution list contains contact information or email addresses and reads on "electronic address book", column 2, lines 25-28), comprising: a transceiver in communication with the network (network interface or modem to communicate with network, Fig. 1, items 158, 160, column 6, lines 35-41); a processor in communication with the transceiver (communicate through bus, Fig. 1, items 102, 106, column 5, lines 39-43); and a memory in communication with the processor (Fig. 1, items 104, 226, 128, 130), and storing processor executable instructions that cause the processor to perform a plurality of actions, including:

accessing, over the network, a plurality of archives of e-mails for an e-mail (Fig. 2, items 210, 220, 230, column 6, lines 55-61);

parsing the e-mail to obtain an e-mail address based at least in part on an application associated with the e-mail (retrieve email address from data store, column 6, lines 61-67, column 7, lines 23-36);

adding the e-mail address to the electronic address book (add to resolution list when email address matches criteria, Figs. 4C, 4D, item 440, column 12, lines 45-64); and

providing to a user device, over the network, an access to the electronic address book (user can save or edit the list, column 2, lines 33-35, PIM module with resolution list may be located remote in a distributed computing environment, column 5, lines 28-33, i.e. user interface access the resolution list, over the network).

As to claim 22, Tafoya discloses the elements of claim 21 as noted above and further discloses wherein adding the e-mail address to the electronic address book further comprises adding the e-mail address if the e-mail address occurs at a certain frequency (Fig. 4B, items 416, 418, 420, column 12, lines 20-30) the e-mail address is similar to another e-mail address (Fig. 4c, item 434), or a date associated with the e-mail address meets a threshold (column 8, lines 57-60).

As to claim 23, Tafoya discloses the elements of claim 21 as noted above and further discloses wherein the electronic address book is stored at least on one of the user device (column 2, lines 33-35), the apparatus, or another network device.

As to claim 24, Tafoya discloses the elements of claim 21 as noted above and further discloses wherein at least one of the plurality archives of e-mails is stored on the apparatus, the user device (database mail store located in local, column 7, lines 30-31), or another network device (Fig. 2, items 210, 220, 230).

As to claim 25, Tafoya discloses the elements of claim 21 as noted above and further discloses wherein the parsing further comprises sending a parsing instruction to cause remote parsing of the e-mail on a network device which stores the plurality of archives of e-mails (access data store to extract email address, column 7, lines 23-36).

As to claim 26, Tafoya discloses the elements of claim 21 as noted above and further discloses wherein each of the plurality of archives of e-mails is associated with a different application (different version software, various contact database or other types of electronic files, column 7, lines 23-36).

As to claim 27, Tafoya discloses the elements of claim 21 as noted above and further discloses wherein at least one of the plurality of archives of e-mails includes e-mails of different applications (different version software, various contact database or other types of electronic files, column 7, lines 23-36).

Claims 28-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Creswell et al. (US Patent 6,564,264, hereinafter "Creswell").

As to claim 28, Creswell discloses an apparatus for use in populating a destination electronic address book over a network (update a user address book couple to the network, Fig. 1, column 3, lines 48-50), comprising: a transceiver in communication with the network; a processor in communication with the transceiver; and a memory in communication with the processor (connect and exchange information with network by any terminal device such as a PC, Fig. 1, column 3, lines 23-35), and storing processor executable instructions that cause the processor to perform a plurality of actions, including:

- accessing a first source electronic address book for a first e-mail address, the first source electronic address book comprising a list of e-mail addresses generated with a first application (access address book for "send to" address, Fig. 3, item 303, column 4, lines 44-47);

- evaluating the e-mail address based on a first defined criterion (check if address exist in the user's data set, Fig. 3, item 303, column 4, lines 47-52); and

- adding the e-mail address to the destination electronic address book if the first defined criterion is satisfied (Fig. 3, item 305, column 4, lines 54-56).

As to claim 29, Creswell discloses the elements of claim 28 as noted above and further discloses wherein the actions further comprising:

- accessing a second source electronic address book for a second e-mail address, the second source electronic address book comprising a list of e-mail addresses generated with a second application (search other database, e.g. white pages or yellow pages supported by YAHOO or ALTA VISTA, Fig. 3, item 313, column 3, lines 61-67);

evaluating the second e-mail address based on the first defined criterion (find required email address, Fig. 3, item 315); and

adding the second e-mail address to the destination electronic address book if the first defined criterion is satisfied (Fig. 3, item 319, column 5, lines 6-9).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 9-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harms et al. (US Publish 2003/0078981, hereinafter "Harms") in view of Huang et al. (US Patent, 5,966,714, hereinafter "Huang").

As to claim 9, Harms discloses a method for use in generating and maintaining an address book (contact list reads on address book, paragraph [0021], lines 1-2), comprising:

Accessing, over a network, an electronic archive comprising a list of e-mail addresses generated with a first application (access through network to retrieve incoming message generated by sender application, Figs. 1-3, paragraph [0031]);

Parsing, over the network, the electronic archive for the e-mail addresses, based on the first application (retrieve e-mail address and/or name based on incoming message or inbox, abstract, Figs. 2-3, paragraph [0007], [0026], lines 2-6);

applying a first criterion to a first retrieved e-mail address (check to see e-mail existing in contact list, Fig. 2, paragraph [0037], lines 3-6, paragraph [0045], lines 2-4); and

adding the first retrieved e-mail address to an electronic address book if the first criterion is met (add e-mail address automatically or after approval, paragraph [0027], paragraph [0031]).

Harms discloses scanning messages in an email inbox to retrieve display names and simple mail transfer protocol (SMTP) addresses of senders and/or recipients for each email (abstract) does not explicitly disclose mail inbox is located in a remote server and searching archive of e-mails associated with different application for an e-mail.

Huang, however, discloses that host PC or network server has a mailbox 124 for storing all received and sent mail messages (Fig. 1c, column 4, line 58 to column 5, line 16) and searching e-mail address from multiple data sources such as e-mail folders and archive, and master address book on the network server (Figs. 1a-1e, column 4, lines 5-18, column 6, lines 2-7).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Harms's disclosure to search for e-mail address of mailbox resided on network server and associated with different applications (such as Msmail, CC:mail) as taught by Huang for the purpose of extracting e-mail address from different sources remotely (Fig. 1a, items 101, 103, Huang). The skilled artisan would have been motivated to improve the invention of Harms per the above such that address book can be populated by different servers/application (column 2, lines 10-15, Huang).

Furthermore, since the mailbox is stored in the server, the combination of Harms and Huang teach parsing, over the network, the electronic archive comprising a list of e-mail address.

As to claim 10, Harms discloses the elements of claim 9 as noted above and further discloses wherein the applying includes applying a second criterion to the first retrieved address (filter address to include message from specified domains as second criterion, Fig. 6, paragraph [0035], lines 11-16); and the adding includes adding the first retrieved address to the electronic address book if both the first and second criteria are met (new e-mail address comes from specified domain will be added, Figs. 2 and 6, paragraph [0036]).

As to claim 11, Harms discloses the elements of claim 10 as noted above and further discloses supplying a plurality of criteria options (filter rules reads on criteria, Fig. 6, paragraph [0026], lines 6-14, paragraph [0035], lines 1-5); and receiving a selection of criteria including the first and second criteria (criteria can be user defined and selected, paragraph [0021], lines 6-14).

As to claim 12, Harms discloses the elements of claim 10 as noted above and further discloses wherein the archive includes an archive of e-mails (message in database or storage device, Fig. 3, paragraph [0030], lines 1-2); and the parsing includes parsing a plurality of fields associated with each e-mail of the archive (plurality of fields - "From Field", "To Field", and "CC Field", paragraph [0035], lines 5-11).

As to claim 13, Harms and Huang discloses the elements of claim 10 as noted above and further discloses accessing, over the network, an external archive comprising a second list of e-mail addresses (paragraph [0030], lines 1-2, Harms) generated with a second application (Fig. 1a, items 101, 103, Huang);

parsing the external archive for e-mail addresses (Fig. 3, Harms, Fig. 1c, Huang);

retrieving e-mail addresses from the external archive (Fig. 3, paragraph [0030], Harms, Fig. 1c, Huang);

applying the first and second criteria (filter address to include message from specified domains as second criterion, Fig. 6, paragraph [0035], lines 11-16, Harms); and

adding the retrieved e-mail addresses from the external archive if the retrieved e-mail addresses from the external archives meet both the first and second criteria (new e-mail address comes from specified domain will be added, Figs. 2 and 6, paragraph [0036], Harms).

As to claim 15, Harms discloses the elements of claim 12 as noted above and further discloses generating a nickname in association with the first e-mail address (display name reads

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on nickname, abstract, lines 2-6); and adding the nickname associated with the first e-mail address to the address book (abstract, lines 6-8).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Que as applied to claim 1 above, and further in view of Creswell et al. (US Patent 6,564,264, hereinafter "Creswell").

As to claim 7, Que disclose the elements of claim 1 as noted above but does not explicitly disclose generating a verification list of at least the e-mail address added to the address book

Creswell discloses verifying the user with message with the updated address information (Figs. 2 and 3, column 2, lines 48-55, lines 63-64, column 4, lines 51-57).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Que's disclosure to include verification of updated e-mail address as taught by Creswell for the purpose of confirmation of updated e-mail address (Fig. 3, item 307, Creswell). The skilled artisan would have been motivated to improve the invention of Que per the above such that added address book can be verified.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Que as applied to claim 6 above, and further in view of Harms et al. (US Publish 2003/0078981, hereinafter "Harms").

As to claim 8, Que discloses the elements of claim 6 as noted above but does not explicitly disclose receiving confirmation of additions based on the retrieved list prior to the adding the e-mail address.

Harms discloses selecting contacts to add the e-mail address (Fig. 4, paragraph [0027], paragraph [0033]).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Que's disclosure to include selecting box next to the search results as taught by Harms for the purpose of identifying which e-mails are to be added (paragraph [0033], Harms). The skilled artisan would have been motivated to improve the invention of Que per the above such that the user can selectively update the contact list based on search results .

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harms and Huang as applied to claim 12 above, and further in view of Montville et al. (US Patent 6356,937, hereinafter "Montville").

As to claim 14, Harms and Huang disclose the elements of claim 12 as noted above and further discloses

determining if the archive includes an organizational folder (e-mail in an organizational folders, paragraph [0002], lines 7-10);

the adding includes adding the first e-mail address to the electronic address book in the generated folder (Fig. 4, paragraph [0027]).

Harms discloses taking personal information from one application to an address book application (paragraph [0005]) but does not explicitly disclose determining if the e-mail address was retrieved from the organization folder; generating a folder within the addresses book; and adding the first e-mail address to the electronic address book in the generated folder.

Montville discloses extracting address from a received message, create folders to hold addresses, and add the address to the folder (column 18, lines 4-12). Montville also discloses generating folders within the Inbox for incoming messages based on a rule (for example, domain or group information) to place the messages into the designated folder (column 18, lines 29-35, column 21, lines 46-49).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Harms and Huang's disclosure to identify the status /source of e-mail address as taught by Montville for the purpose of providing information about the source of message and organizing the message accordingly (column 21, lines 46-58, Montville). The skilled artisan would have been motivated to improve the invention of Harms and Huang per the above such that address book can be stored in folders in such a way that they group those addresses with something in common (column 18, lines 12-16, Montville).

Response to Amendment and Remarks

Applicant's arguments with respect to claims 9-12 and 15 have been considered but are moot in view of new grounds of rejection. Refer to the corresponding sections of the claim analysis for details.

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Applicants argue that Tafoya does not appear to teach or suggest providing to a user device, *over a network*, an access to the electronic address book. The Examiner respectfully disagrees.

Tafoya discloses the invention may also be practiced in distributed computing environments where tasks are performed by remote processing devices that are linked through a communications network. Program modules (such as PIM) can be located on remote device (column 5, lines 28-33). Therefore, Tafoya teaches the limitation, "providing to a user device, over a network, an access to the electronic address book".

Applicants argue that Tafoya does not teach, "wherein the e-mail address is automatically excluded if the e-mail address occurs below the certain frequency". The Examiner respectfully disagrees.

Tafoya discloses wherein adding the e-mail address to the electronic address book further comprises adding the e-mail address if the e-mail address occurs at a certain frequency. It would have been obvious to a person of ordinary skill in the art to recognize when adding the e-mail address based on a certain frequency, under that condition, any e-mail with frequency falls below the certain frequency will be automatically excluded.

Regarding Applicants' argument that the email resolution list of Tafoya is not an electronic address book. The Examiner has addressed the subject matter in the last Office Action, therefore, the stance regarding the status of claim 21, and all those claims depending on it, remains the same as stated in the previous Office Action.

Applicants argue that Creswell does not appear to teach or suggest that the first e-mail address be accessed from a first electronic address book. The Examiner respectfully disagrees.

Creswell clearly teaches accessing user's data set (address book) for the e-mail address as shown in column 4, lines 44-51.

Conclusion

Applicant's amendment necessitated the new grounds of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shew-Fen Lin whose telephone number is 571-272-2672. The examiner can normally be reached on 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a

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general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

July 5, 2007

Shew-Fen Lin
Patent Examiner
Art Unit 2166


HOSAIN ALAM
VISORY PATENT EXAMINER